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09/935,120	08/22/2001	Todd Robert Colas	NOW0730	8373

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EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/935,120

Applicant(s)

COLAS ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This office action is responsive to amendment filed May 3, 2005. Claims 1-26 are currently pending.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 6, 10, 12 and 20, recite “ad template means” or “ad template” for specifying company advertiser and ad publisher business rules. The specification, disclose template means or template for preparation and administration of ads but does not disclose template for specifying the role and rules for preparation and administration. The specification discloses means for specifying rules and roles, however does not teach template for specifying the rules and roles.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over “GMTI To Giveaway ROLEX Watch at NEXPO 2000” (hereinafter GMTI) in view of Pareschi et al. U.S. Patent No. 6,725,428 further in view of Gannett Media Technologies International “Gannett Media Technologies International to Exhibit at Seybold New York/ Exhibit to feature Celebro Advertising Solutions and Digital Collections Multimedia Management System” <http://www.gmti.com/newsdetail.asp?newsTitle>, April 16, 1999 (hereinafter Gannett).

Regarding claims 1-4, GMTI teaches template means for preparation and administration of ads for publication by roles according to business rules. GMTI teaches accepting advertisers data placing the data into custom-designed ad templates and electronically delivers the ads for publication. GMTI teaches database for storing ad templates and formatting ads for at least one ad delivery medium, (see page 1). GMTI does not explicitly teach template for specifying advertiser and publisher business rules and roles. Pareschi teaches means for specifying rules and roles for a work process or task such as publishing papers based on a set of rules and roles and the use of a template (see col. 5 lines 18-67, col. 6 lines 5-12, lines 58-67, col. 7 lines 1-67). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention was made to for GMTI to use Pareschi’s method/system of specifying roles and rules in GMTI’s preparation and administration of ads in order to specify the rules and roles of the advertisers and publishers. It would have been obvious for GMTI to specify the rules and role of the advertisers and publishers, since the task or work requires a collaborative

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input of multiple individuals or departments such as the advertisers and publisher for the preparation and administration of the ads, as taught in GMTI. GMTI teaches that the service being provided by a database application services, however does not explicitly suggest that the ad template comprising publisher and advertiser rules and role are stored in a database. Gannett teaches providing advertisers the capability to control the design scheduling and content of their advertising working off a central server. It would have been obvious to one of ordinary skill in the art at the time of the invention for the rules and role and the ad template to be stored in a database, as taught by Gannett, in order for the GMTI system to accept data from advertisers through the Internet, and place it into custom-designed ad templates and to electronically deliver the ads to publishers.

Regarding claim 3, GMTI does not explicitly teach ad template comprising a web browser. Gannett teaches Internet access supported for browsers. It would have been obvious to one of ordinary skill in the art at the time of the invention for GMTI' to access the ad template through the Internet using a browser in order to easily navigate the Web and access the data.

Regarding claims 5-10, 13-19 GMTI as modified, teaches advertisers designing ads using templates. Pareschi teaches instance having a status for indicating its stage of preparation and administration, specifying the rules and roles, defining a plurality of entries for each instance, determining instance deadlines, determining attributes, (see col. 6 line 5 to col. 7 line 67). Gannett teaches advertisers creating ads with varied content and design, and schedule ads for their choice of media. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made for GMTI to indicate the stage of preparation and administration using Pareschi' instance, in order for

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users to use the template to design their own ads, as in GMTI and to select the content and design, and to schedule the ads for publication, as taught in Gannett. GMTI does not explicitly teach Ad Master template for preparing the layout of an Ad Master and ad master instance having status for indicating the stage of preparation and administration, defining components for each Ad Master instance, the components comprising Ad Box instance. Official notice is taken that is old and well known in the art of publishing, also as indicated by applicant (see applicant's specification page 1), to set Ad box and Ad master format, the Ad master comprising Ad Boxes. It is also well know to specify attributes such as width, length, height, font, etc., of the Ad Box or Ad Master. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Ad Master template, the template defining components for each Ad Master instance, the components comprising Ad Box instance to prepare the layout of Ad Master, and to indicate the stages of preparation and administration of ads so that the custom-designed ad templates can be electronically delivered to the newspaper-output for publication, as taught by GMTI. It would have been obvious to one of ordinary skill in the art at the time of the invention to specify attributes in order to specify the sizes of the ads or the font used for the ads in the custom design of GMTI. One would be motivated to provide such system, which allow advertisers to specify the attributes of the ads, in order for the publisher to lay the ads according to the choice of the advertiser, as taught by Gannett, and to price the ads accordingly.

Regarding claims 11, 12, GMTI does not teach each of the roles perform at least one of; creating, editing and database storing of ad box default template or ad master template, etc. Pareschi teaches roles performing one of creating, editing and storing of

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template etc (see col. 9 line 50 to col. 10 line 63). It would have been obvious to one of ordinary skill in the art at the time of the invention for GMTI to use Pareschi's method of specifying the roles of creating, editing or storing and each roles to perform at least one of the roles of creating, editing, and database storing of Ad Box and associated rules, etc., in order to create the custom-designed ad template of GMTI.

Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pareschi et al. U.S. Patent No. 6,725,428 in view of NAA® Presstime: NEXPO'97 Report, Presstime, <http://www.naa.org/presstime/97nexpo/nexad.html>, (hereinafter NAA). "GMTI To Giveaway ROLEX Watch at NEXPO 2000" (hereinafter GMTI).

Regarding claim 20, Pareschi teaches template for specifying business rules and roles of individuals and for preparation and administration of tasks such as publication (see col. 5 lines 18-67, col. 6 lines 5-12, lines 58-67, col. 7 lines 1-67). NAA teaches providing newspaper-supplied ad templates permitting advertisers to create ads for print, audiotex and WWW by taking information from database and turn the text and photos into newspaper ads, choose a schedule and send the ads to newspapers' ad database (see page 4-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to specify the rules and roles of advertisers and publishers using Pareschi's system by putting advertisers in control of the design of the ads and to automatically transmit ads to the newspaper in order to reduce error, as taught by NAA (see page 4). Therefore, Pareschi as modified by NAA teaches the preparing and administering ads for publication by the specified roles and rules and storing the rules and roles in the ad template in a database and storing the prepared ads in a database.

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Regarding claims 21-22, Pareschi as modified teaches ad template but does not explicitly teach Ad Master template for preparing the layout of an Ad Master and ad master instance having status for indicating the stage of preparation and administration, defining components for each Ad Master instance, the components comprising Ad Box instance. Official notice is taken that is old and well known in the art of publishing, also as indicated by applicant (see applicant's specification page 1), to set Ad box and Ad master format, the Ad master comprising Ad Boxes and indicating the stage of preparation and administration. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Ad Master template, the template defining components for each Ad Master instance, the components comprising Ad Box instance to prepare the layout of Ad Master for publication, and to indicate the stages of preparation and administration of ads so that the advertiser can design the ads using the newspaper-supplied ad templates and to deliver ads to the newspaper database for publication, as taught by NAA.

Regarding claims 22-24, GMTI, ad modified teach each of the roles perform at least one of; creating, editing and database storing of ad box default template or ad master template, etc. Pareschi teaches roles performing tasks such as one of creating, editing and storing of template etc (see col. 9 line 50 to col. 10 line 63). It would have been obvious to one of ordinary skill in the art at the time of the invention to specify rule and roles for individuals performing tasks and for each roles to perform at least one of the roles of creating, editing, and database storing of Ad Box and associated rules, etc., in order to create the custom-designed ads.



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Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over “GMTI To Giveaway ROLEX Watch at NEXPO 2000” (hereinafter GMTI) in view of Pareschi et al. U.S. Patent No. 6,725,428 further in view of Gannett Media Technologies International “Gannett Media Technologies International to Exhibit at Seybold New York/ Exhibit to feature Celebro Advertising Solutions and Digital Collections Multimedia Management System” <http://www.gmti.com/newsdetail.asp?newsTitle>, April 16, 1999 (hereinafter Gannett).

Regarding claim 25, GMTI teaches a host system, a data storage, remote communication facilities exchanging data with the host through a network, processing means associated with the host enabling the host to accept and store and retrieve and transmit database records from and to respective facilities, input means permitting advertisers and publishers at the remote facilities to prepare and administer ads for publication. GMTI does not explicitly teach input means permitting advertisers and publishers at the remote facilities to specify the inputs to define advertiser and publisher roles and rules. Pareschi teaches personal specifying the inputs to define individuals’ role and rules for the preparation and administration of a task such as publication (see col. 5 lines 18-67, col. 6 lines 5-12, lines 58-67, col. 7 lines 1-67). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention was made for someone to specify the role and rule of GMTI ad publication using Pareschi’s input means for the ad to be designed by the advertiser and published by the publisher as disclosed in GMTI.

Regarding claim 26, GMTI teaches a fully scaleable client server application running under Microsoft’s Windows NT operation system.

*Response to Arguments*

Applicant's arguments filed May 3, 2005 have been fully considered but they are not persuasive.

In regard to the rejection of "112", applicant argues that the claims was amended as agreed to an Office Interview by Examiner, conducted on June 23, 2004. Examiner agreed to the amendment in order for applicant to clearly claim applicant's invention. Examiner did not read the specification at the time of the interview for new matter issue. During the examination the Examiner became aware that the specification does not disclose such feature. The "112" rejection is appropriate therefore, still stands.

Applicant argues that the Examiner alleges that the GMTI does not explicitly suggest that the ad template, publisher and advertiser rules and roles are stored in a database. Examiner would like to point out that there was a type mistake and meant to specify that the GMTI does not explicitly suggest that the "ad template comprising publisher and advertiser rules and roles are stored in a database" as claimed.

As best understood by the Examiner and as it was indicated in the Interview, applicant claimed invention is related to preparation and administration of an advertisement. Applicant's specification (see "Field of the Invention") discloses that the present invention provides a system and method for companies and publishers to cooperate in the joint creation, editing and arrangement of text, images audio and video for inclusion in a publication's advertising media space and in the joint administration of the advertisement preparation process. The prior art GMTI, teaches the end result, which is the template or the process of advertisement preparation as set by the company rules,

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i.e., the template providing advertisers the ability to create ads online. Since the template or page provided by the company allows advertiser, who are provided access, to enter specific information in specific place according to the template provided, which suggests that rules and roles are set. The GMTI is silent to the steps taken to provide the end result, i.e., the ad placement process. Pareschi was introduced for the teaching of setting rules and roles using template. For example the role of authors, who write and research the paper, consultants who advise from the sidelines, copy-editor who proof read and comment and publishers who publish paper, and rules for deadlines for submission, refereeing, revising and publishing and page limit of the paper are defined. Applicant asserts, "that GMTI does not teach or suggest rules and roles therefore does not and cannot teach that something that is does not teach is stored in database". Applicant also asserts that neither GMTI nor Gannett suggest a database for storing said ad template comprising company advertiser and ad publisher business rules, personnel roles, and ads prepared and administered by said roles and rules. As stated before, since GMTI teaches a template for preparation of ads by leading the advertiser through the ad-creation process and allows the advertiser to edit and correct the ads placed. Also since advertisers who are provided access, can only place the ad according to the process set, by the system, it suggests that rules and roles were set, so that every advertiser goes through the same process of placing the ads. Since more than one advertiser is accessing the process of preparation of the ads remotely and since every advertiser can also store the ads, this suggests that the database is networked. Gannett was introduced to support that the system and database are networked. According to Gannett the system provides advertisers the capability to control the design scheduling and content of their advertising

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working off a central server, which suggests that the database is at a central server.

Examiner would like to point out that both articles used, the GMIT and the Gannett articles, are about the Celebro advertising solution introduced by GMTI. GMTI, which is a system integrator and software developer serving the printing and publishing industry, is a subsidiary of Gannett. Thus, the Gannett article is introduced for the teaching in which GMIT article is silent. The Pareschi patent is introduced for the setting of rules and roles so that the GMIT customer's (advertisers) can use the system (Celebro advertising software) accordingly.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yehdega Retta  
Primary Examiner  
Art Unit 3622

YR